

REMARKS

The claims are 17-21.

The claims have been re-drafted to moot two bases for rejection. The term "Tentagel" has been replaced by a generic description. Attached are two sheets from Acros Organics, a vendor of Tentagel, which supports this generic description. Claim 12 has also been re-drafted as claim 17 to moot the Markush language issue.

Claims 12, 13, 15, and 16 are rejected under 35 USC 112 for lack of written description. The rejection is traversed. The Examiner's rejections are substantially the same as those raised in the Action of April 9, 2002 and these were responded to in the Reply of September 9, 2002. Those comments are incorporated herein.

The Examiner has now made additional comments, which are responded to below.

The Examiner has represented the present claims and field of technology in two ways, both of which are incorrect. First, the claims are said to "encompass an infinite number of variations". This is a factually incorrect statement. Although the generic claim covers a large number of compounds, the compounds are not infinite in number. If an infinite claim had been presented for examination, there might be some basis for rejection, since no amount of exemplification would approach infinity. This mis-characterization of the claims is inappropriate and should be withdrawn or supported. The rejections based on this mis-characterization must also be withdrawn. A rejection must be based on what is being claimed, not on the Examiner's mis-statement thereof. The Examiner has also mis-stated the level of predictability in this art. Throughout the Action the Examiner has referred to the "unpredictability of the art". Although unpredictability is a fundamental basis for the rejections, the Examiner neither defines what this unpredictability level is nor provides any support whatsoever for stating that this art is unpredictable. To the contrary, it is deemed that the field of combinatorial synthesis on solid supports is a mature art with a high level of predictability with regard to synthetic methods. In support of this statement, attached are the claims from various patents in this field.

USP 6,721,099 claims a solid support with a compound attached thereto. The Examiner's attention is directed to the following terms, which are not further defined in claim 1: solid support, identifier, CEC' is a tag, F¹ is a functional group, and F² is a linking component. None of these terms provide structural limitations or points of attachment and they use "functional" language: e.g., identifier, tag, functional, and linking. The claims are very broad.

Similarly, USP 6,503,759 claims a solid support with a compound attached thereto. The Examiner's attention is directed to the following expression in claim 1: "said identifiers being bound to said solid support either directly or indirectly or through other than a tag component of another identifier."

Similarly, USP 5,766,963 claims a chemical library. The Examiner's attention is directed to the following terms, which are not further defined in claim 1: S is a solid support, L is a first linker, L' is a second linker, and T is a tag.

These patents, as well as many of the numerous technical publications and patents cited on their first pages, are evidence that chemical synthesis on solid supports is a mature art wherein terms such as "linker", "solid support", "functionalized", etc. are commonly used without need of further definition or limitation in order to be understood by one of ordinary skill in the art. The grant of these three US patents (which were examined by three different examiners) demonstrates that these expressions meet the requirements of 35 USC 112. These patents also demonstrate that compound claims need not recite specific points of attachment between different moieties to meet the requirements of 35 USC 112. (If necessary, additional examples of US patents could be provided.)

The Examiner has recited U. of Ca. vs Lilly (43 USPQ2d, 1398) in support of the rejection. However, this case is fully supportive of applicants' arguments. In Lilly, the court clearly distinguishes between DNA cases and chemical cases. At page 1406, the court states that in chemical cases a generic formula "is normally an adequate description" whereas with genetic material it is not. The Examiner has also mis-stated the law with regard to examples. The Examiner states that "adequate disclosure ... requires *representative examples*" (Examiner's emphasis). The court in Lilly disagrees ": "Mention of representative compounds ... clearly is not required by § 112 or by any other portion of the statute".

The present claims are directed to compounds containing elements A, B, C, and D. As discussed above, the solid supports represented by A are well known in the art. Claims reciting solid supports have been allowed in US patents. Similarly, B represents a cleavable linker. Again, this language has been allowed in US patents. The reason for these allowances is that synthesis on solid supports is a mature field and these terms would be well understood by those of ordinary skill in the art. The terms C and D are defined by structure in the claims. It is deemed that these claims are fully enabled and described.

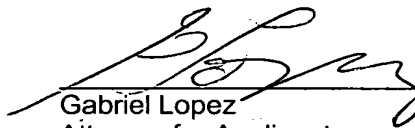
Claims 12-16 are rejected under 35 USC 112 as being indefinite. The rejection is traversed. Responses to Examiner's para. 18 A, C, D, and E have already been provided above. Para. 18 G is essentially a repetition of the rejection based on structure and linkages, which has also been responded to above. Regarding 18 B, the dashes on D and D' in the formulas are points of attachment. This is not confusing to one in the chemical arts. Regarding 18 F, claim 14 is properly dependent on claim 12. A dependent claim can further limit an element recited in a prior claim. However, a dependent claim can also add an element which has not been recited in a prior claim, as long as said claim is not limited by language such as "consisting of".

The Examiner states that once an Examiner has established a *prima facie* case of lack of enablement, the burden shifts to the applicant. For the reasons provided above, it is deemed that a *prima facie* case has not been established.

It is requested that the amendment be entered since it moots rejections in the Action and places the claims in better condition for appeal. It is further requested that the Examiner reconsider the rejection in view of the amendment, remarks, and attached documents and that the case be passed to issue.

Respectfully submitted,

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encl Acros Organics (2 sheets)

Claims of USP 5,721,099, 5,766,963, and 6,503,759

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